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By

Signature

Katrina A. Lyon



MS No. 150732.1
Attorney Docket No. MCS-119-99
PATENT APPLICATION
USPTO CUSTOMER NUMBER: 27662

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of
Greden et al.

Group Art Unit: 3625

Entitled: A SYSTEM AND METHOD
FOR MANAGING AND
CONTROLLING ACCOUNTS WITH
PROFILE INFORMATION

Examiner: Rhode, R.

Serial No.: 09/584,232

Filing Date: May 31, 2000

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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I. REAL PARTY IN INTEREST

The subject application is assigned to Microsoft Corporation, of Redmond
Washington.

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II. RELATED APPEALS AND INTERFERENCES

There are no known related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-27 represent all claims currently pending in the application. These claims are provided for reference in the Appeal Brief Appendix. The rejection of claims 1-27 is hereby appealed.

IV. STATUS OF AMENDMENTS

No amendments are currently pending.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER.

In general, the Appellants' claim a system and method for finding a prospective buyer and automatically providing the identity of the buyer to agents offering for sale products or services. As for the independent method claims, the Appellants' claimed invention provides the buyer with an interactive environment having information relating to the products or services offered by the agents (page 8, lines 13-15). A profile of the buyer is created by inferring criteria desired by the buyer based on the buyer's interaction with the interactive environment (page 8, lines 16-24). In one embodiment, the buyer's profile is automatically generated. (page 9, lines 6-9). The profile and the inferred criteria are compared with the criteria of the products or services offered by the agents to match a suitable agent with a suitable buyer based on the created inferred profile of the buyer (page 8, line 25-28). The identity of the suitable buyer can be automatically provided to the suitable agent (page 8, line 28 through page 9, line 5). As for the independent system claim, the appellants claim a computer system for target marketing prospective buyers, comprising: an interactive browsing environment that

allows the prospective buyers to browse information relating to at least one of products or services, each represented by discreet criteria and offered by agents (page 10, line 30 through page 11, line 8); a profile generator that creates and stores profiles of the buyers by inferring criteria desired by the buyers based on the interactive browsing of the buyers (page 11, lines 9-15) ; and a comparator that matches the generated profiles and the inferred criteria of the buyers to similar criteria representing products or services offered by an agent and automatically provides an identity of matching prospective buyers to the agent without action by the agent (page 11, lines 16-22; page 8, line 28 through page 9, line 5).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL.

In the final Office Action dated November 29, 2004, and reaffirmed in the Advisory Action of Feb 25, 2005, Claims 1-27 were rejected under 35 USC 103(a) as being unpatentable over Burge, U.S. Patent No. 6,014,638, in view of Rizzo, U.S. Patent No. 6,470,338. The Examiner contended that it would have been obvious to combine Burge with the system and method of Rizzo to match a suitable agent with a suitable buyer based on a created profile of the buyer. The Examiner contended that although Burge does not disclose automatically providing the identity of the suitable buyer to the agent without action from the agent, Rizzo does. The Appellants respectfully disagree with this contention of obviousness.

VII. ARGUMENT

A. The 35 USC 103 Rejection of Claims 1-27.

1. Missing Claimed Element.

Claims 1-27 were rejected under 35 USC 103(a) as being unpatentable over Burge, U.S. Patent No. 6,014,638, in view of Rizzo, U.S. Patent No. 6,470,338. The Examiner contended that it would have been obvious to combine Burge with the system and method of Rizzo to match a suitable agent with a suitable buyer based on

a created profile of the buyer. The Examiner contended that although Burge does not disclose automatically providing the identity of the suitable buyer to the agent without action from the agent, Rizzo does. The appellants respectfully disagree with this contention of obviousness.

In the Advisory Action of May 19, 2005, the Examiner's rationale for the rejection of Claims 1-27, under 35 USC 103(a) as being unpatentable over Burge (U.S. Patent No. 6,014, 638) in view of Rizzo (U.S. Patent No. 6,470,338) was as follows,

"In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *in re Keller*, 642 F. 2d 413, 208 USPQ 871 (CCPA 1981); *In re Merk & Co.*, 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Additionally and in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F. 2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F. 2d 347, 21 USPQ2d 1941 (Fed. Cir 1992). In this case, both references disclose a need embodied in a method in order to more effectively match a buyer and agent/seller. Moreover, the applicant's arguments that the references are not compatible and therefore cannot be combined are not persuasive because each reference disclose the requirement to match a buyer and a seller/agent based on the sellers interaction with a website. With regard to applicant's arguments that Rizzo requires a manual response is not persuasive because the agent/recipient of the message is provided the identity of the potential buyer as noted in the Final Rejection."

The Final Office Action states the Rizzo discloses providing the identity of the suitable buyer to the suitable agent without action from the agent at Col. 1, lines 45-48,

Col. 4, lines 12-21 and FIG. 5B. FIG. 5 shows a system-assigned case ID and user-entered case information that does not include the buyer's identity such as name or other information that would allow an attorney to know who the user is so that he or she could contact them directly without going through the system. The cited passages will be discussed later below.

The appellants' claimed invention encompasses a system and method for finding a prospective buyer and providing the buyer to agents offering for sale products or services. The appellant's claimed invention provides the buyer with an interactive environment having information relating to the products or services offered by the agents. A profile of the buyer is created by inferring criteria desired by the buyer based on the buyer's interaction with the interactive environment. The profile and the inferred criteria are compared with the criteria of the products or services offered by the agents to match a suitable agent with a suitable buyer based on the created inferred profile of the buyer. The identity of the suitable buyer is automatically provided to the suitable agent without required action from the agent.

Burge teaches a system for customizing content and presentation of content for computer users. The system monitors and records a user's navigational choices to determine the user's needs and preferences for subsequent computer displays. Displays are customized in accordance with the user's needs and preferences. In a preferred embodiment of the present invention, an electronic marketing and shopping system accessible via the WWW is described. The shopping environment-including the opportunities presented to the shopper (content) and the appearance of the displays (presentation of content)-is customized according to the shopper's preferences. The functions of data collection and display customization are performed automatically by the electronic shopping system. To customize the environment, various attributes of Web pages or other displays provided by participating merchants are modified as they are accessed by shoppers using the system. (Abstract) **Burge merely displays certain items to the buyer based on the buyer's past preferences. No seller's criteria are used to match a buyer to a seller and provide the seller the buyer's**

identity. Burge does not provide the identity of a suitable buyer to a suitable agent. In Burge it is impossible for the seller to obtain the buyer's identity.

Granted, the Examiner states that Burge does teach providing the identity of the buyer to a suitable agent at Col 5, lines 16-37 and lines 51-67, as well as Col. 6, lines 1-5. These passages state:

“The merchant computer 90 may have access to a database 92 describing the products and services available from the merchant. Information regarding the merchant and the merchant's products and services may be communicated to the electronic shopping manager and preferably is stored in a shopping database 86 to which the electronic shopping manager host computer 84 has access. Information regarding individual shoppers may also be stored in the shopping database 86 to which the electronic shopping manager host computer 84 has access. Alternatively, all merchant data may be stored remotely at the various merchant sites. **The electronic shopping manager customizes shopping opportunities and related displays by analyzing the available shopper and merchant data.** With access to information regarding the two participants in the shopping transaction (shopper and merchant), the present invention configured as an electronic shopping manager is able to meet the needs of both the shopper and the merchant. **The shopper is presented with the opportunity to view and purchase that merchandise that is most likely to be of interest. The merchant's products and services are directed toward those shoppers who have, either directly or indirectly, expressed an interest in them....** Operations to accomplish a customized electronic shopping environment in accordance with the present invention may occur in two principle phases. In the first phase, data regarding the shopper's preferences are collected. Raw data relating to the electronic shopping options, such as specific sites and specific products selected by the

shopper, entry and exit times for the sites, number of visits to the sites, etc., are recorded and processed to create a shopping profile for the shopper. Raw data may then be processed to create a preference profile for the shopper. The profile may also include personal data or characteristics (e.g., age, address, hobbies) regarding the shopper as provided by the shopper when subscribing to the service. **Following the data collection phase is the display customization phase.** During the display customization phase, displays with content regarding (1) general merchant information or options and/or (2) specific merchant product and service information or options are customized to conform to the shopper's preferences as indicated in the shopper's profile. **A predictive model is applied to the profile data to select display characteristics and elements**--such as the nature of items selected for the shopper, similarities to products recently purchased, icon or button locations, colors for background, icons/buttons, and text, fonts, etc.--for generating a display that is likely to reflect the shopper's preferences."

Nowhere do these passages state that the identity of the buyer is provided to the seller. The seller's products are merely displayed to the buyer based on the buyer's shopping preferences based on a predictive model. The agent cannot directly contact the buyer because the buyer's identity is not known.

The Examiner argues that, "In purchasing a product online, it well known that the seller would obtain the identity of the buyer with the input of the name and credit number of the buyer. " **But Burge merely customizes the display of prospective buyers.** The credit card number and name of the buyer are not available for prospective buyers because no sale has been made.

The Examiner further states that identity is defined as "a characteristic that identifies the buyer through generic characteristic such as a file/message identified for example with a case ID and a short description of their individual needs." However, this

definition of identity is not sufficient to allow an agent to directly contact a buyer.

The Office Action states that Rizzo teaches a method and system for automatically providing the identity of the suitable buyer to the suitable agent without action from the agent at Col. 1, lines 54-57, Col. 4, lines 12-21 and FIG. 5B. However, FIG. 5 merely shows a system-assigned case ID and user-entered case information that does not include the buyer's identity such as name or other information that would allow an attorney to know who the user is so that he or she could contact them directly without going through the system. The cited passages state,

“A computerized method for matching potential clients with professional services providers which meet their personalized criteria and are interested in providing particular services to them including the steps of: presenting a first electronic document including a plurality of data entry devices to the potential clients via a computer network; receiving data entered using the data entry devices, **the received data being indicative of the criteria**; automatically comparing the received data to data stored in a storage medium to identify one or more suitable professional services providers; automatically generating and transmitting via the computerized network an electronic mail message to the identified one or more service providers, **the electronic message including information indicative of a portion of the received data**; and, receiving a response from at least one responding one of the one or more identified service providers, and **automatically providing information indicative of another portion of the received data to the responding one of the service providers.**”

Rizzo teaches a computerized method for matching potential clients with professional services providers which meet the buyer's specified criteria. Specifically, Rizzo's system is set up for a client in need of attorney services. Hence, when the data entered by the client is sent out to one or more suitable attorneys only part of the client's information is provided. **The client's identity that**

would allow direct contact (name, email and phone number) is not provided (Figure 1 a, step 270). In order to retrieve the client's identity the attorney must manually go to a website and request to retrieve it (Figure 1 a, step 290).

Clearly, as indicated in the cited paragraph above, Rizzo does not automatically provide the client's identity to the attorney without the need for the attorney to perform manual actions. This is intentional so as to provide a means for the attorney to preclude conflicts in representing clients.

In order to deem the appellants' claimed invention unpatentable under 35 USC 103, a prima facie showing of obviousness must be made. To make a prima facie showing of obviousness, all of the claimed elements of an appellant's invention must be considered, especially when they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Burge does not teach automatically providing the identity of a buyer to a suitable agent. Likewise, Rizzo does not teach automatically providing the identity of a buyer to a suitable agent without the agent having to take action. Thus, the combined teachings of these two references also lacks this claimed feature. In the aforementioned Office Action, the Examiner argues that "in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually". However, the applicants have shown that a claimed element is missing from both references and so is missing from the combination. This does not constitute "attacking the references individually". Rather, it shows the combined teaching are insufficient to show obviousness. It is also noted that Burge or Rizzo do not recognize the advantages of the aforementioned claimed feature, such as a reduced effort for the agent. Hence, no prima facie case of obviousness has been established in accordance with *In Re Fine*.

2. No Motivation to Combine/Destruction of Function.

Furthermore, it is the appellants' position that there is no motivation to modify the Burge teachings with those of Rizzo because such a combination would destroy the stated function of the Burge invention.

Burge teaches a system for customizing content and presentation of content for computer users. The system monitors and records a user's navigational choices to determine the user's needs and preferences for subsequent computer displays. The functions of data collection and display customization are performed automatically by the electronic shopping system to allow the display of the products of many merchants' items from which the buyer can choose. If the user does not show a preference for a particular merchant's types of goods, this merchant's goods will never be displayed to the buyer. Burge does not allow for a merchant to directly contact a buyer to try to get them to buy their goods. And Burge does not allow the seller to select the buyer he wishes to do business with. In Rizzo the data collection functions are manual as the user specifies the desired criteria and they are not inferred. Rizzo allows the seller to select and contact the buyer if the seller is willing to provide the buyer goods/services after taking action to retrieve the buyer's contact information. Therefore, modifying Burge with the Rizzo teachings would destroy the Burge invention's function of allowing the buyer to select from many sellers based on the user's preferences (and not the other way around where the seller selects from many buyers). Furthermore, modifying Burge with Rizzo would also destroy Burge's automated function by the substitution of manual actions required by Rizzo for matching a buyer to seller (e.g., the displays could no longer be updated based on the inferred criteria of the buyer using the predictive model).

It is well settled in the law that a 35 USC 103 rejection based on a modification of prior art that destroys the function of the invention disclosed in the prior art, is improper and does not establish a prima facie case of obviousness. *In*

Re Gordon, 733 F.2d 900,221 USPQ 1125 (Fed. Cir. 1984). **There is simply no technological motivation for a worker to make such a detrimental modification. To the contrary, a significant disincentive exists.** In this case, the proposed substitution of Rizzo's requirement that the seller select the buyer and that a client (buyer) provide the necessary matching criteria rather than it being inferred would destroy the functionality of the Burge invention and so a prima facie case of obviousness cannot be established from the cited references based on the precepts of *In Re Gordon* as well.

Granted, in response to the appellants' similar arguments for patentability presented in reply to a previous Office Action, the Examiner stated in the last Office Action that the arguments were unpersuasive because, "the two references disclose the need for more effective matching... and thereby the obvious combination of the two further enhances the matching process without destroying the intent or the technology of either reference." **But clearly, modifying Burge with the Rizzo teachings destroys the functionality of Burge, which is contrary to showing of obviousness to combine.** This is not only the view of the applicable case law, but of the U.S. Patent & Trademark Office as well, as expressed in MPEP Section 2143.02 (page 2100-127, Rev. 1, Feb. 2003) where under the heading "THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE" it is stated:

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification".

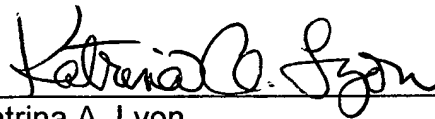
In view of the lack of a prima facie case of obviousness, the remaining rejected Claims 1-27 cannot be deemed to be unpatentable under 35 USC 103 over Burge in view of Rizzo. As such, it is respectfully requested that the rejection of Claims 1-27 be reversed based on the following claim language, as exemplified by Claim 1:

"A computer implemented method for finding a prospective buyer and providing the identity of the buyer to agents offering for sale at least one of products or services, the method comprising using a computer to perform the following process actions...providing the buyer with an interactive environment having information relating to the products or services offered by the agents; creating a profile of the buyer by inferring criteria desired by the buyer based on the buyer's interaction with the interactive environment; comparing the profile and the inferred criteria with criteria of the products or services offered by the agents to match a suitable agent with a suitable buyer based on the created profile of the buyer; **and automatically providing the identity of the suitable buyer to the suitable agent without action from the agent.**"

For the foregoing reasons, it is respectfully submitted that the Examiner's rejection of Claims 1-27 was erroneous. As such, reversal of the Examiner's decision is respectfully requested at the earliest opportunity.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Katrina A. Lyon", written over a horizontal line.

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VIII. CLAIMS APPENDIX.

1. A computer implemented method for finding a prospective buyer and providing the identity of the buyer to agents offering for sale at least one of products or services, the method comprising using a computer to perform the following process actions:

providing the buyer with an interactive environment having information relating to the products or services offered by the agents;

creating a profile of the buyer by inferring criteria desired by the buyer based on the buyer's interaction with the interactive environment;

comparing the profile and the inferred criteria with criteria of the products or services offered by the agents to match a suitable agent with a suitable buyer based on the created profile of the buyer; and

automatically providing the identity of the suitable buyer to the suitable agent without action from the agent.

2. The computer implemented method of claim 1, wherein the interactive environment includes allowing the buyer to graphically interact with information relating to the products or services.

3. The computer implemented method of claim 2, wherein the buyer selects information relating to the products or services.

4. The computer implemented method of claim 3, wherein the profile is

created based on the selections made by the buyer during interaction with the interactive environment.

5. The computer implemented method of claim 1, wherein the interactive environment includes providing an interactive questionnaire to the buyer.

6. The computer implemented method of claim 1, wherein the method operates on a computer-readable medium having computer-executable instructions for finding a prospective buyer and providing the buyer to an agent offering for sale at least one of products or services.

7. The computer implemented method of claim 1, further comprising the process action of creating a database of buyer profiles and defining groups of specific criteria for specific buyers.

8. The computer implemented method of claim 7, further comprising the process action of providing agents access to the database to allow the agents to locate specific buyers based on criteria defined by the agents.

9. The computer implemented method of claim 1, wherein comparing the profile and the inferred criteria with criteria of the products or services includes matching specific products or services of the agents that the buyer has a potential interest in based on the generated profile of the buyer.

10. A computer system for target marketing prospective buyers, comprising:
an interactive browsing environment that allows the prospective buyers to browse information relating to at least one of products or services, each represented by discreet criteria and offered by agents;

a profile generator that creates and stores profiles of the buyers by inferring criteria desired by the buyers based on the interactive browsing of the buyers;
and

a comparator that matches the generated profiles and the inferred criteria of the buyers to similar criteria representing products or services offered by an agent and automatically provides an identity of matching prospective buyers to the agent without action by the agent.

11. The computer system of claim 10, wherein the interactive browsing environment is a graphical user interface.

12. The computer system of claim 10, wherein the profile is created based on the browsing habits of the buyer during interaction with the interactive environment.

13. The computer system of claim 10, wherein the buyers are provided with selections relating to the products or services during interaction with the interactive environment.

14. The computer system of claim 13, wherein the profile is created based on the selections made by the buyer during interaction with the interactive environment.

15. The computer system of claim 10, wherein the interactive environment is a graphical interactive questionnaire.

16. The computer system of claim 10, wherein the system operates on a computer-readable medium having computer-executable instructions for finding a prospective buyer and providing the buyer to an agent offering for sale at least one of products or services.

17. The computer system of claim 10, wherein the comparator creates a database of buyer profiles and defines groups of specific criteria for specific buyers.

18. The computer system of claim 17, wherein the agents are provided with access to the database to allow the agents to locate specific buyers based on criteria defined by the agents.

19. The computer system of claim 10, wherein the comparator compares the profile and the inferred criteria with criteria of the products or services by matching specific products or services of the agents that the buyer has a potential interest in based on the created profile of the buyer.

20. A method for finding a prospective buyer of real estate and providing the identity of the buyer to real estate agents offering real estate for sale, the method comprising:

providing the prospective buyer with a computer implemented system having an interactive environment with information relating to the real estate offered by the agents;

automatically generating a profile of the buyer by inferring criteria desired by the buyer based on interaction with the interactive environment by the prospective buyer; and

comparing the generated profile and the inferred criteria with criteria of the real estate offered by the agents to match a suitable agent with a suitable buyer based on the generated profile of the buyer; and

automatically providing the identity of the suitable buyer to the suitable agent without action from the agent.

21. The method of claim 20, wherein the interactive environment is provided within a graphical user interface.

22. The method of claim 20, wherein the profile is automatically generated based on the interaction of the buyer with the interactive environment.

23. The method of claim 22, wherein the buyer is provided with selections relating to real estate offered by the agents during interaction with the interactive

environment.

24. The method of claim 20, wherein the interactive environment is a graphical interactive questionnaire.

25. The computer implemented method of Claim 1 wherein comparing the profile and the inferred criteria with criteria of the products or services offered by the agents to match a suitable agent with a suitable buyer based on the created profile of the buyer is automatic.

26. The system of Claim 10 wherein the comparator automatically compares the generated profiles and the inferred criteria of the buyers with similar criteria representing products or services offered by the agent for allowing the agent to locate prospective buyers.

27. The method of Claim 20 wherein comparing the generated profile and the inferred criteria with criteria of the real estate offered by the agents to match a suitable agent with a suitable buyer based on the generated profile of the buyer is automatic.

IX. EVIDENCE APPENDIX.

Not applicable.

X. RELATED PROCEEDINGS APPENDIX.

None.